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In the Supreme Court of the United States

OCTOBER TERM, 1946.

No. 292.

THE UNION METAL MANUFACTURING COMPANY,
and
EDMUND W. RIEMENSCHNEIDER, and
MABEL ST. ELMO RASTETTER,
Executrix of Harry O. Rastetter, Deceased,
Petitioners,

vs.

CASPER W. OOMS,
as Commissioner of Patents,
Respondent.

PETITION FOR REHEARING.

HARRY FREASE,
EDWARD R. WALTON, JR.,
Counsel for Petitioners.

EVERETT R. HAMILTON,
JOSEPH FREASE,
Of Counsel.

Washington, D. C.,
November 6, 1946.

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CASPER W. OOMS,
as Commissioner of Patents,
Respondent.

PETITION FOR REHEARING.

Come now the above-named petitioners, and present this their Petition for a Rehearing of the Petition for Certiorari in this case.

I.

JURISDICTION.

The Petition for Certiorari was filed on July 12, 1946; and was denied on October 14, 1946. This petition is filed within less than twenty-five days thereafter, under Rule 33 of this Court.

II.

REASONS FOR PETITION FOR REHEARING.

1. The ultimate error in the decision of the Court of Appeals below, is that it constitutes judicial legislation and is based on judge-made law, the evil effects of which are set forth in *The Imperiled Position of Our Patent System,* a judicial Address by United States District Judge

Clarence G. Galston before the Association of the Bar of the City of New York on May 14, 1945. 149 F. 2d xxiii.*

2. *The Trends in Federal Law and Procedure,* a judicial Paper by United States District Judge Grover M. Moscowitz, 5 F. R. D. 361,* points out the public importance of properly constraining erroneous judicial legislation and judge-made law by lower courts, by compelling decisions of the Supreme Court.

III.

Re JUDICIAL LEGISLATION.

1. The ultimate error of the Court below was in deciding each one of the questions presented below, by judicial legislation, in a manner contrary to relatively recent decisions of this Court, and without the support of any pertinent decision by any other one of the United States Circuit Courts of Appeals.

2. In seeking to justify proper judicial legislation, Judge Galston says that—

> "Lower courts are, of course, constrained by the compelling decisions of the United States Supreme Court." (p. XXIV)

The Court below was not so constrained, because the judge-made law on each one of the questions presented, was neither dependent on nor established by any decision of this Court.

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* Judge Galston's Address was published only in the advance sheets of 149 F. 2d XXIII, which were not preserved by counsel for the petitioners; and did not come to their attention until reading Judge Moscowitz's Paper; whereupon a copy of the Address was obtained from the West Publishing Company on October 21, 1946, one week after the Petition for Certiorari was dismissed, and was then read for the first time by Counsel for Petitioners. A copy of the Address obtained from Honorable Eugene J. Keogh, a member of Congress from New York City who is Chairman of the House Committee on Revision of the Laws, is submitted herewith.

IV.

Re JUDICIAL USURPATION.

1. The errors below are something more than mere judicial legislation. They amount to judicial usurpation with respect to each one of the questions presented, and are all decided in defiance of controlling decisions of this Court.

2. If judicial legislation by lower Courts imperils our patent system and should be constrained by compelling decisions of this Court, the patent system is even more imperiled by judicial usurpation in lower Courts and must be absolutely prevented by positive action in this Court, if our patent system is to be preserved.

V.

CONSTITUTIONAL PROVISIONS.

1. It is well said by Judge Galston that—

> "It cannot be gainsaid that the framers of the Constitution had no pre-vision of the giant industrial corporations of the present age, nor of the research laboratories which wise administration and foresight by their management created.
>
> "But other clauses of the Constitution have yielded to changed economic conditions. Why should difficulty be encountered in a liberal interpretation of the Constitutional clause respecting inventions?
>
> "The promotion of the 'progress of science and useful arts' was the primary object of the Constitutional provision. The reward to the inventor was but a secondary consideration.
>
> "Progress in the arts and sciences was the all important aim—the reward only the means suggested." (p. XXIX)

2. To the same effect it is said by Judge Moscowitz that—

> "Our industrialization has progressed rapidly under a system which encourages competitive research and invention by affording relative assurance of compensation for successful creative effort.

"Those who argue that invention would continue although the reward be removed are overlooking human experience; the greater the protection afforded an inventor, the greater will be his endeavors." (p. 376)

VI.

PUBLIC IMPORTANCE OF THE ERRORS.

1. A call upon this Court for affirmative action is made by Judge Galston, as follows—

"Progress of industry under patent protection is generally conceded.

"Now a changing judicial attitude suggests the need of thorough exploration of underlying conditions affecting the issuance and the use of letters-patent if the aim of the Constitution is to be preserved." (p. XXIV)

2. In conclusion, it is pointed out by Judge Galston that—

"If the objective of the Constitutional provision is to be attained, it would seem the path of expediency and of necessity to aid rather than to obstruct invention.

"There has been ample testimony throughout the years by eminent commentators that without the proffer of patent protection it would have been impossible to create, or maintain after creation, a great number of the industries which marked the progress of the United States in the application of science to human needs.

"Nor can anyone fail to realize our critical dependence in this war upon the inventions that were developed in peace time as well as during the progress of the war.

"Of necessity too, post-war planning must contemplate encouragement to initiate industries, as well as to carry on the old, by holding out the awards which a sound patent system should promote." (pp. XXX, XXXI)

3. The conclusions of Judge Galston have a direct bearing on the petitioner's improvement, which not only founded a new industry, but as pointed out in the Reply Brief in Support of Petition—

> "During the recent World War II there were many crying needs which had to be satisfied if the prosecution of the war was to be successful.
>
> "The genius of Americans and American Industry satisfied those needs and solved the problems existing.
>
> "The steps taken by Riemenschneider and Rastetter in solving the problem of handling cargo by ship booms, created by the need of transporting locomotives, tractors and tanks, aeroplanes and jeeps, and heavy war material of every description, across the seven seas to the four corners of the earth, is but one example of the exercise of such genius." (Reply Brief, p. 3)

VII.

THE IMPERILED POSITION APPLIED.

In a single decision affirming the District Court, the Court below jumped over all the barriers which have been built around the patent statutes by this Court for preserving the ultimate purpose of the Constitution, which is to promote the development of the arts and sciences; and in so doing the Court below arbitrarily usurped the exclusive prerogative of this Court to overrule or modify its own previous decisions.

1. (a) Both Courts below actually annulled several decisions of this Court in denying patentability to sub-combination claims after inclusive combination claims were allowed; such denial being directly contrary to the rule of decision established by this Court in *Railroad Company v. DuBois* (1870) 12 Wall. 47, 60, and *Special Equipment v. Coe* (1945) 324 U. S. 370, 376 (Petition for Certiorari, pp. 15, 16).

(b) The denial of sub-combination claims was also contrary to an express provision in Title 35, Section 63,

United States Code, under which the action was brought (Id. 17).

2. (a) Both Courts below erroneously failed to follow the law established by this Court in refusing a patent upon evasive findings and conclusions. See *Fletcher v. Peck* (1810) 6 Cranch 87, 147, and *Mayo v. Canning Co.* (1940) 309 U. S. 310, 316 (Id. 19).

(b) Both Courts below also ignored the twelve undisputed facts specified in the Petition for Certiorari (p. 21); and its denial of invention in the pending claims is a refusal to follow the rule of this Court in *Goodyear v. Ray-O-Vac* (1944) 321 U. S. 275, 279 (Id. 22).

3. Both Courts below erroneously refused to follow the rule of this Court, in failing to find the facts specially and to state conclusions of law separately on all the issues that the case presents; as required by Rule 52(a) of Civil Procedure, interpreted in *Interstate Circuit v. United States* (1938) 304 U. S. 55, 56, and in *Kelley v. Everglades* (1943) 319 U. S. 415, 420 (Id. 24).

4. Both Courts below, in effect, overruled this Court in denying invention upon several prior patents as a matter of fact, when "*no extrinsic evidence was given or needed to explain terms of art*"; contrary to the rule of this Court that in such a situation the question of invention is a matter of law, as established by *Market Street v. Rowley* (1895) 155 U. S. 621, 625, and *United States v. Esnault-Pelterie* (1938) 303 U. S. 26, 30 (Id. 27).

The single decision of the Court below constitutes judicial legislation, because the Court has either annulled, or has refused to follow, or has in effect overruled controlling decisions of this Court on each one of the four questions presented to the lower Court.

VIII.

For the foregoing reasons, your petitioners respectfully urge that a rehearing be granted; that upon further consideration the order of October 14, 1946 denying the petition for certiorari be revoked; and that the writ of certiorari issue.

HARRY FREASE,
EDWARD R. WALTON, JR.,
Counsel for Petitioners.

EVERETT R. HAMILTON,
JOSEPH FREASE,
Of Counsel.

Washington, D. C.,
November 6, 1946.

We, Harry Frease and Edward R. Walton, Jr., counsel for the above named petitioners, The Union Metal Manufacturing Company, and Edmund W. Riemenschneider and Mabel St. Elmo Rastetter, Executrix of Harry O. Rastetter, Deceased, do hereby certify that the foregoing petition for a rehearing of this cause is presented in good faith and not for delay.

HARRY FREASE,
EDWARD R. WALTON, JR.,
Counsel for Petitioners.